REMARKS

This paper is a preliminary amendment being filed simultaneously with an RCE for Serial No. 09/944,684. A Final Office was filed against the above-mentioned application on July 27, 2005. Previously, claims 1-25 were pending. After amending claims 1, 2, 4-6, 9-10, 14, and 16, canceling claims 3 and 15, and adding claims 26 and 27, claims 1-2, 4-14, and 16-27 remain pending.

In Section 3, the Office Action states that claims 1-2 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Mazzagatte et al. ("Mazzagatte"; US 6,862,583) in view of Kocher (US 6,188,766). The Office Action actually states that the claims have been rejected under "U.S.C. 102(e)", but the Applicant assumes that this is a typographical error, and that the Examiner intended to write "U.S.C. 103(a)." Claim 1 has been amended to include the subject matter of claim 3, now canceled. Since claim 3 has not been rejected as unpatentable with respect to the combination of Mazzagatte and Kocher, the Applicant assumes that this rejection is now moot.

In Section 4 of the Office Action, claims 3-25 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to the Mazzagatte, in view of Kocher and Weschler, Jr. ("Weschler"; US 6,651,047). With respect to claims 3, 13, and 14, the Office Action acknowledges that Mazzagatte fails to describe the storage and selection of profiles from a directory. The Office Action states that Weschler describes directories that are data structures with information such as addresses and public key information (col. 4, ln. 22-26, and col. 5, ln. 13-

33). The Office Action states that the combination of Mazzagatte and Kocher teach a profile which includes "the transmission protocol having an encryption field", and that it would have been obvious to store such a profile in a directory "because a directory indicates where the profile is located for profile services which includes search and retrieve methods for accessing existing profiles". This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

> First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck* 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991).

Mazzagatte creates a print job at a sending node, i.e., a desktop computer 10 print driver (col. 7, ln. 46-55). The sending node submits the job to a print node along with unique identification information (col. 8, ln. 19-29). The print node encrypts and stores the print job after it is received (col. 8, ln. 62-67). After the user arrives at the print node and presents their unique user identification information, the print node decrypts the print job and prints it (col. 9, ln. 26-35).

As acknowledged in the Office Action at page 18, Kocher discloses a standard fax machine, which is capable of transmitting a

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scanned document (col. 4, ln. 35-55). The patent's novelty appears to be that faxed documents are sent to a timestamping service, which maintains an archive of timestamped fax documents (Abstract).

Weschler describes a secure data record storage mechanism (Abstract). In his Background Section, Weschler states that directories are a problematic method of finding resources in a distributed system, as directories contain duplicate information and are difficult to maintain (col. 4, ln. 22-30). At col. 5, ln. 10-35, Weschler describes a prior art Domain Name System (DNS), which uses a Lightweight Directory Access Protocol (LDAC) to make domain name searches. At col. 10, ln. 59-67, Weschler describes a core profile engine that maintains a set of meta-data about every profile. The meta-data controls how the core profile engine makes profile data available to client applications.

With respect to the *first prima* facie requirement, the Office Action fails to provide any motivation to combine references in a manner that suggests the claimed invention. Since Mazzagatte describes the use of the SSL protocol to send encrypted print jobs, the combination of Mazzagatte with Kocher may suggest a service that saves timestamped print jobs, as a means of verifying that the jobs were sent. Alternately, the combination may suggest fax jobs sent using an SSL transmission protocol. This combination is not at all close to the Applicant's recitation of a profile, where each profile includes an address field and an encryption field. Even if Weschler's directory is added to the combination, the combination does not suggest the Applicant's recitation of profile. That is, the combination of references does not describe the process of selecting a profile, where the profile gives directions as to how a scanned document is

to be encrypted and the destination address to which the encrypted document is to sent.

The motivation to combine references cannot be a retrospective analysis based upon a keyword search that uses the claimed invention limitations. Rather, the test must be forward looking. One reference must actually suggest a modification to another reference. The Applicant respectfully submits that a timestamp repository for fax documents suggest few modifications to a print driver. Likewise, a data architecture whose novelty is in keeping a single copy of a data record appears to offer no modifications to either a fax device or a print driver. "It is impermissible to reconstruct the claimed invention from selected pieces of prior art absent some suggestion, teaching, or motivation in the prior art to do so. *Interconnect Planning Corp. v. Feli*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985).

With respect to the second *prima facie* requirement, even if an expert were given the Mazzagatte, Kocher, and Weschler references as a foundation, no insight has been provided in the Office Action as to how this expert would come up with the claimed invention. The combination of references does not provide an expectation of success that a scanning device can be established with a directory that permits scan jobs to be automatically encrypted and sent to an address in response to selecting a profile from the directory.

With respect to the third requirement to support a *prima facie* case of obviousness, the combination of references does not teach all the limitations of claims 1, 13, and 14. In the *Response to Arguments* Section of the Office Action, it states that the word "profile" can be interpreted to be a "transmission mode comprising a type of transmission

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protocol that indicates whether to encrypt prior to transmission". To further clarify the invention, claims 1, 13, and 14 have been amended to recites that a profile is a computer text file. Clearly, a transmission protocol is not a text file with encryption and address fields.

None of the cited references describes the selection of a profile, where a profile is a computer text file that includes an address field and an encryption field. None of the cited references describe the encryption of a scanned document using the encryption field of the selected profile. None of the references describe sending the encrypted documents to destination using the address field of the selected profile. All of the above-mentioned features are recited in claims 1, 13, and 14 of the claimed invention. Therefore, the combination of the Kocher, Weschler, and Mazzagatte does not explicitly describe all the elements of claims 1, 13, and 14. Neither do the references suggest any modifications that make these claims obvious. Claims 4-12, dependent from claim 1, and claims 16-25, dependent from claim 14, enjoy the same distinctions, and the Applicant respectfully requests that the rejection be removed.

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It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

Respectfully submitted,

Date:___10/18/2005___
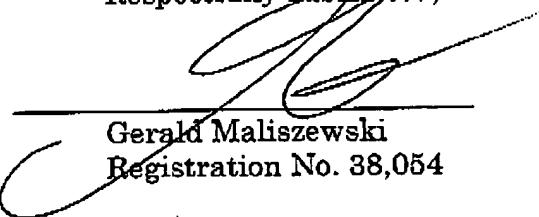
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